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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,959	11/21/2003	Geun Su Lee	30205/39514	4436

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EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,959	Applicant(s) LEE, GEUN SU	
	Examiner Sin J. Lee	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 11-20 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

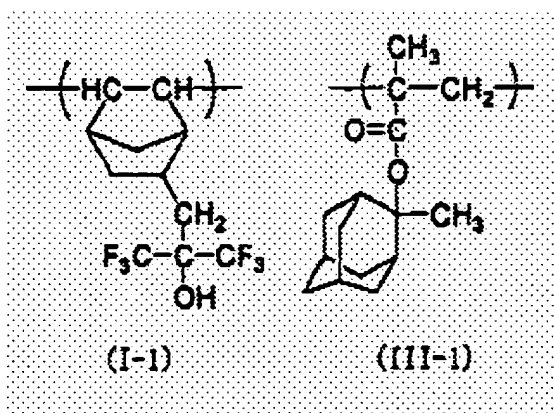
- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3, 8, and 11-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishimura et al (EP 1 164 434 A2) (with Momota et al (US 2002/0172886 A1, which is being cited here to support the Examiner's position that the methylene group in the repeating unit (III-1) of Nishimura's Resin A-23 would not materially affect the basic and novel characteristic(s) of the present invention).

In Example 17 (see Table 1 of pg.54 and [0288]), Nishimura teaches a radiation sensitive resin composition containing 90 parts by weight of Resin A-23, 2.5 parts by weight of a photoacid generator, and 530 parts by weight of a solvent (propylene glycol monomethyl ether acetate). The Resin A-23 is described in [0277], and it has the following structure;



wherein the copolymerization molar ratio of the repeat unit (I-1) and (III-1) is 50:50. On pg.11, lines 30-53, Nishimura teaches the equivalence of the -CH₃ in the α -position of

the repeat unit (III-1) and a hydrogen atom (see line 53 where it is stated that R⁶ represents a hydrogen atom or methyl group). Since there are only two choices for R⁶, one of ordinary skill in the art would immediately envisage the repeat unit (III-1) shown above in which the –CH₃ group in the α-position is replaced with a H atom, and the moiety of –C(CH₃)(C(=O)-O-methyladamantyl)- in (III-1), in which –CH₃ group in the α-position is replaced with a H atom, teaches present unit “b”. Present unit “c” can be 0 mol%.

Although Nishimura’s resin does contain –CH₂- moiety, it is the Examiner’s position that the prior art still teaches present photoresist polymer of claims 1 and 3 for the following reasons: Applicants use the transitional phrase “consisting essentially of” in present claim 1 (*applicants are not using the transitional phrase “consisting of”*). The phrase limits the scope of a claim to the specified materials “and those that do not *materially* affect the *basic and novel* characteristic(s)” of the claimed invention. See In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976), as cited in MPEP 2111.03. The –CH₂- moiety is generally known in the art as an inert group, for example, see Momota et al, [0049]. Therefore, it is the Examiner’s position that the –CH₂- moiety in Nishimura’s resin would not materially affect the basic and novel characteristic(s) of the present invention. Besides, it was held in PPG Industries v. Guardian Industries, 156 F.3d 1351, 1355, 48 USPQ 2d 1351, 1355 that for the purposes of applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.”. Also, it was held in In re De Lajarte, 337 F.2d

870, 143 USPQ 256 (CCPA 1964) that if an applicant contends that additional materials in the prior art are excluded by the recitation of "consisting essentially of," *applicant* has the *burden* of showing that the introduction of additional components would materially change the characteristics of applicant's invention.

Therefore, for those reasons cited above, Nishimura teaches present inventions of claims 1, 3, 8, and 12.

With respect to present claim 11, since Nishimura uses 90 parts by weight of Resin A-23 and 2.5 parts by weight of a photoacid generator, this gives 2.8 wt.% of the photoacid generator based on the amount of the resin. Therefore, the prior art teaches present invention of claim 11.

With respect to present claim 13, since Nishimura uses 90 parts by weight of Resin A-23 and 530 parts by weight of the solvent, this gives 589 wt.% based on the amount of the resin. Therefore, the prior art teaches present invention of claim 13.

Nishimura teaches (see [0200]-[0204] and [0215]) that a resist pattern is formed from his radiation-sensitive resin composition by applying the composition solution to a substrate such as a silicon wafer to form a resist film, pre-baking the coated resist film, exposing it to radiation such as visible rays, UV rays, deep UV rays, X-rays, electron beams or the like (particularly preferable radiation being *ArF excimer laser* or *KrF excimer laser*), performing post-exposure bake at 90°C, and then developing the exposed resist film using an alkaline aqueous solution to form a predetermined resist pattern. Therefore, Nishimura teaches present inventions of claims 14-19 (since Nishimura teaches the same kinds of radiation source as the present invention, it is the

Examiner's position that the prior art would inherently teach the present exposure energy range of claim 18).

With respect to present claim 20, Nishimura teaches ([0289]) that his radiation-sensitive resin composition is capable of producing semiconductors at a high yield without producing resolution defects during microfabrication. Therefore, the prior art teaches present invention of claim 20.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura et al (EP 1 164 434 A2).

In the Resin A-23 shown above, the repeat unit (III-1) has the 2-methyl-2-adamantyl group as the acid-labile group, and on pg.11, lines 30-50, lines 53-58, and [0066]-[0068], Nishimura teaches the equivalence of the 2-methyl-2-adamantyl group and t-butyl group (i.e., all R^7 groups of the formula (4) on pg.11 are methyl groups). Because the prior art teaches the equivalence of these two groups, it would have been obvious to one of ordinary skill in the art to replace the 2-methyl-2-adamantyl group in the repeat unit (III-1) of Resin A-23 with a t-butyl group (as an acid-labile group) with a reasonable expectation of obtaining a resin composition exhibiting high transmittance of radiation, high sensitivity, resolution, and pattern shape. Therefore, Nishimura's teaching would render obvious present invention of claim 2.

Allowable Subject Matter

5. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Nishimura does not teach or suggest the use of present photoacid generator of claim 9 in combination with his inventive resin.

6. Claims 4-7 are allowed. Nishimura does not teach or suggest present method of forming the photoresist polymer of Formula 1.

Response to Arguments

7. Applicants argue that the photoresist polymer of amended claim 1 excludes a situation where one of the monomer moieties includes a methyl group off of the main chain as in Formula (III-1) of Nishimura and thus that the amended claim 1 is no longer anticipated by Nishimura. Applicants also argue that Nishimura's resin comprises repeat units of formulas I-1 (which comprises a polycyclic group) and III-1 which comprise a methacrylate group unit as the main chain and thus that Nishimura does not disclose a photoresist polymer that comprises a single carbon moiety having an ester group such as units b or c of amended claim 1.

However, as explained above, although Nishimura's resin does contain $-CH_2-$ moiety, the prior art still teaches present photoresist polymer of amended claim 1 because it is the Examiner's position that the $-CH_2-$ moiety in Nishimura's resin would not materially affect the basic and novel characteristic(s) of the present invention, in the absence of applicant's showing that the introduction of $-CH_2-$ moiety would materially change the characteristics of applicant's invention (*applicants are not using the transitional phrase "consisting of" which would exclude the presence of the $-CH_2-$*

moiety in Nishimura's resin). Also, as explained above, Nishimura teaches the equivalence of the $-CH_3$ in the α -position of the repeat unit (III-1) and a hydrogen atom, and one of ordinary skill in the art would immediately envisage the repeat unit (III-1) shown above in which the $-CH_3$ group in the α -position is replaced with a H atom. The moiety of $-C(CH_3)(C(=O)-O\text{-methyladamantyl})-$ in (III-1), in which $-CH_3$ group in the α -position is replaced with a H atom, teaches present unit "b", and present unit "c" can be 0 mol%. Therefore, Nishimura does teach present photoresist polymer that comprises present unit b or c of amended claim 1.

For the reasons explained above, present rejections still stand.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Lee

S. Lee

October 25, 2005

Sin J. Lee

SIN LEE
PRIMARY EXAMINER